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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,272	04/30/2001	Yves, Louis Gabriel Audebert	L741.01103	1050

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Stevens, Davis Miller & Mosher, LLP
Suite 850
1615 L Street, NW
Washington, DC 20036

EXAMINER

SON, LINH L D

ART UNIT	PAPER NUMBER
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2135

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,272

Applicant(s)

AUDEBERT ET AL.

Examiner

Linh LD Son

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>See Office Action</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responding to the Amendment received on 10/04/2005.
2. Claims 1-23 are pending.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on (1) 10/01/01, (1) 01/17/03, (9) 11/16/04, (1) 04/14/05, (1) 07/21/05, (1) 08/09/05 was filed after the mailing date of the 04/30/01. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Urien, US/6944650B1, in view of DiGiorgio et al , US/6385729B1, hereinafter "DiGiorgio".

6. As per claim 1:

Urien discloses "A system for transferring proprietary information through a communications pipe established between at least a first remote computer system and at least a personal security device using a local client as a communications host for said personal security device" in (Col 1 line 64 to Col 2 line 12), said system comprising:

"at least one network, wherein said network includes means for functionally connecting at least one local client with said at least one first remote computer system" in (Col 1 line 64 to Col 2 line 12);

"said local client further comprising means for functionally connecting to a personal security device Interface and said network, means for functionally communication over said network with said remote computer system" in (Col 1 line 64 to Col 2 line 12) and;

"means for establishing a communications pipe, said means for establishing a communications pipe comprising: client communications means for transmitting and receiving message packets over said network using a packet based communications protocol, and for transmitting and receiving APDUs through said personal security

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device Interface” in (Col 10 line 50 to Col 11 line 25, Col 2 line 63 to Col 3 line 33, Col 9 lines 35-45); and

“first client (Packet Multiplexer, Figure 3, Col 10 line 52, Col 10 line 60 to Col 11 line 8) data encapsulated means for receiving incoming message packets from said remote computer system using said client communications means separating encapsulated APDUs from said incoming message packets thus generating des-encapsulated APDUs and routing said des-encapsulated APDUS to said personal security device through said personal security device Interface independently of the origin and integrity of said incoming message packets” in (Figure 3, Col 13 lines 23-43, Col 14 lines 16-36, Col 9 lines 10-43, and Col 20 lines 20-31);

“second client data processing means (Packet Multiplexer, Figure 3) for receiving incoming APDUS from said personal security device interface, encapsulating said incoming APDUS into outgoing message packets and routing said outgoing message packets to said remote computer system through said client communications means” in (Col 18 lines 55-65, and Col 9 lines 10-43);

“said at least one personal security device further comprising at least one embedded personal security device application, a microprocessor, a runtime environment and at least one internal memory location, wherein said embedded application receives proprietary information through said established communications pipe and stores said

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information in said internal memory location and wherein said personal security device is functionally connected to said client and is functionally communicating with said client and said first remote computer system through said established communications pipe” in (Fig 1B, Col 3 line 40-48); and “said at least one first remote computer system further comprising means for transferring said proprietary information from a storage location through said established communications pipe, wherein said first remote computer system is functionally connected to said network and is functionally communicating with said client and said personal security device through said established communications pipe” in (Col 15 lines 27-46).

However, Urien does not directly disclose the “encapsulated means for receiving incoming message packets from said remote computer system using said client communications means separating encapsulated APDUs from said incoming message packets”, and “encapsulating said incoming APDUS into outgoing message packets and routing said outgoing message packets to said remote computer”;

Nevertheless, Digiorgio discloses a method of “encapsulated means for receiving incoming message packets from said remote computer system using said client communications means separating encapsulated APDUs from said incoming message packets”, and “encapsulating said incoming APDUS into outgoing message packets and routing said outgoing message packets to said remote computer” in (Col 9 lines 1-44).

In Col 19 line 5, Digiorgio also discloses the implementation of ISO-7816 Standard, which is also implemented in Urien’s patent to generate APDUs message and translating APDUs message (Col 14 lines 17-36).

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Therefore, it would have been obvious for one having ordinary skill in the art at the time of the invention was made to incorporate DiGiorgio with Urient's teaching to provide the encapsulation and des-encapsulation method process the data packet prior sending to the remote server successfully.

7. As per claim 2:

Urien and Digiorgio disclose "the method according to claim 1, further comprising; encrypting said proprietary information by said first remote computer system prior to transmitting said proprietary information through said communications pipe, and decrypting said encrypted proprietary information after receiving said proprietary information through said communications pipe by said PERSONAL SECURITY DEVICE" in (Col 20 lines 20-32, and Col 15 lines 26-55).

8. As per claim 3:

Urien and Digiorgio disclose "the system according to claim 1, wherein said memory location is an open location" in (Fig 1B, Col 18 line 8-12).

9. As per claim 4:

Urien and Digiorgio disclose "the system according to claim 1, wherein said memory location is a secure location" in (Fig 1B, Col 3 line 40-48).

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10. As per claim 5:

Urien and Digiorgio disclose "The system according to claim 1, further comprising receiving, processing and routing means for transferring said proprietary information received over said network from at least one subsequent remote computer system through said established communications pipe to said personal security device" in (Col 13 lines 23-43, Col 14 lines 17-30, and Col 15 lines 26-46).

11. As per claim 6:

Urien and Digiorgio disclose "the system according to claim 1, wherein said storage location is local to said first remote computer system" in (Col 22 line 5-25).

12. As per claims 7-8, and 14:

Urien and Digiorgio disclose "the system according to claim 1". However, Urien and Digiorgio are not directly teach "wherein said storage location is local to at least one subsequent remote computer system or with at least one subsequent remote computer system". Nevertheless, Urien does disclose of providing access to documents from the server ends in (Col 2 line 21-34). It would have been obvious for one having ordinary skill in the art to at the time of the invention was made to realize that the documents must be stored somewhere locally on the server or on a remote storage server.

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13. As per claim 9:

Urien and Digiorgio disclose "The system according to claim 8, wherein said subsequent remote computer system is functionally connected to said network and is functionally communicating with said first remote computer system using said network" in (Col 1 lines 5-35).

14. As per claims 10:

Urien and Digiorgio disclose "the system according to claims 1, wherein said established communications pipe employs an open communications protocol" in (Col 9 lines 1-10).

15. As per claims 11:

Urien and Digiorgio disclose "the system according to claims 1, wherein said established communications pipe employs a secure communications protocol" in (Col 15 lines 25-46).

16. As per claims 12 and 17:

Urien discloses "A method for transferring proprietary information through a communications pipe between at least a first remote computer system and at least a personal security device using a local client as a communications host for said

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PERSONAL SECURITY DEVICE" in (Col 1 line 64 to Col 2 line 12), said method comprising:

"establishing a communications pipe between said PERSONAL SECURITY DEVICE and said first remote computer system over at least one network and using said client as a communications host for said PERSONAL SECURITY DEVICE" in (Col 1 line 64 to Col 2 line 12),

"wherein said client and said remote computer system are in functional communication using a packet based communications protocol over said network, and wherein transmitting a message from said remote computer system to said personal security device through said communications pipe" in (Col 1 line 64 to Col 2 line 12)

"comprises: generating a message on said remote computer system, "wherein said message is in a non-native protocol for communicating with said personal security device and said message is generated by an API Level Program, converting on said remote computer system said message from said non-native protocol into an APDU format message using a first server data processing means" in (Col 10 line 50 to Col 11 line 25, Col 2 line 63 to Col 3 line 33, Col 9 lines 35-45),

"encapsulating on said remote computer system said APDU format message into said packet based communications protocol producing an encapsulated message, using a second server data processing means, transmitting said encapsulated message over said network using said packet based communications protocol, receiving by said client said encapsulated message sent over said network, processing said encapsulated

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message using a first data processing means to separate said APDU format message from said encapsulated message, and “routing on said APDU format message through a hard device port assigned to a personal security device Interface, independently of the origin and integrity of said encapsulated message, wherein said personal security device interface is in processing communication with said personal security device” in (Packet Multiplexer, Figure 3, Col 10 line 52, Col 10 line 60 to Col 11 line 8, Col 13 lines 23-43, Col 14 lines 16-36, Col 9 lines 10-43, and Col 20 lines 20-31);

“Retrieving said proprietary information from a storage location by said first remote computer system, processing said proprietary information by said first remote computer system” in (Col 2 lines 23-35), “transmitting said proprietary information through said established communications pipe to said PERSONAL SECURITY DEVICE” in (Col 15 lines 26-53), “receiving said proprietary information through said communications pipe from said first remote computer system by said PERSONAL SECURITY DEVICE, and storing said proprietary information in a memory location inside said PERSONAL SECURITY DEVICE, using at least one embedded internal algorithm” in (Col 20 lines 13-31).

However, Urien does not disclose directly the “encapsulating on said remote computer system said APDU format message into said packet based communications protocol producing an encapsulated message, using a second server data processing means,” and “processing said encapsulated message using a first data processing means to separate said APDU format message from said encapsulated message.” Nevertheless, Digiorgio discloses a method of “encapsulated means for receiving incoming message

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packets from said remote computer system using said client communications means separating encapsulated APDUs from said incoming message packets”, and “encapsulating said incoming APDUS into outgoing message packets and routing said outgoing message packets to said remote computer” in (Col 9 lines 1-44). In Col 19 line 5, DiGiorgio also discloses the implementation of ISO-7816 Standard, which is also implemented in Urien’s patent to generate APDUs message and translating APDUs message (Col 14 lines 17-36).

Therefore, it would have been obvious for one having ordinary skill in the art at the time of the invention was made to incorporate DiGiorgio with Urien’s teaching to provide the encapsulation and des-encapsulation method process the data packet prior sending to the remote server successfully.

In regard to the “encapsulating on said remote computer system said APDU format message into said packet based communications protocol producing an encapsulated message, using a second server data processing means” limitation, Urien and DiGiorgio do not specifically teach the limitation. Nevertheless, the des-encapsulation method at the client computer terminal does disclose in DiGiorgio patent (See above). Therefore, it would have been obvious at the time of the invention was made for one having ordinary skill in the art to realize that the process of encapsulation said APDU format message in to said packet based communication must exist in DiGiorgio’s invention.

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17. As per claim 13:

Urien and Digiorgio disclose "the system according to claim 12, wherein said storage location is local to said first remote computer system" in (Col 22 line 5-25).

18. As per claims 15, 18, and 20:

Urien and Digiorgio disclose "the system according to claims 12, and 17, wherein said established communications pipe employs an open communications protocol" in (Col 9 lines 1-10).

19. As per claims 16, 19, and 21:

Urien and Digiorgio disclose "the system according to claims 12, and 17, wherein said established communications pipe employs a secure communications protocol" in (Col 15 lines 25-46).

20. As per claims 22 and 23:

Urien and Digiorgio disclose "the method according to claim 17, and 22, further comprising; encrypting said proprietary information by said first remote computer system prior to transmitting said proprietary information through said communications pipe, and decrypting said encrypted proprietary information after receiving said proprietary information through said communications pipe by said PERSONAL SECURITY DEVICE" in (Col 13 lines 23-43, Col 14 lines 17-30, and Col 15 lines 26-46).

Response to Arguments

21. Applicant's arguments, see Amendment after Final, filed 10/04/05, with respect to the rejection(s) of claim(s) 12-23 under 35 U.S.C 102 (b), and the rejections of claims 1-11 under 35 U.S.C 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Urien and DiGiorgio. See rejection above.


22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Linh LD Son whose telephone number is 571-272-3856. The examiner can normally be reached on 9-6 (M-F).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Linh LD Son
Patent Examiner



KIM VU
ASSISTANT PATENT EXAMINER
TECHNOLOGY CENTER 2100